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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,830	06/26/2003	Himansu M. Gajiwala	2507-5300.1US (21870-US-0)	7592
60794	7590	10/12/2006	EXAMINER	
TRASKBRITT, P.C. P.O. BOX 2550 SALT LAKE CITY, UT 84110			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 10/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,830

Applicant(s)

GAJIWALA, HIMANSU M.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,14,15 and 20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7,8,14,15 and 20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding objections and rejections, except for those given below, are withdrawn in light of applicant's amendment filed 7/28/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed 7/28/2006. In particular, claims 7 and 14 have been amended to include "at least one curing agent." Thus, the following action is properly made final.

Claim Rejections - 35 USC § 112

4. Claims 7, 8, 14, 15, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 7 and 14, the term "at least one curing agent" fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the generic term "at least one curing agent" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. While there is

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support for sulfur which behaves as a curing agent in Table 1 on page 10 in Table 8 page 19 of the specification, there is no support for the generic term “at least one curing agent.”

With respect to claims 8, 15, and 20, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

5. Claims 7, 8, 14, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herring ‘841 (US 4,501,841) in view of Trask et al (US 4,726,987).

The rejection is adequately set forth in paragraph 6 of Office action mailed 4/25/2006 and is incorporated here by reference.

6. Claims 7, 8, 14, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herring ‘841 (US 4,501,841) in view of Trask et al (US 4,726,987) and further in view of Herring ‘431 (US 4,878,431).

The rejection is adequately set forth in paragraph 7 of Office action mailed 4/25/2006 and is incorporated here by reference.

Response to Arguments

7. Applicant's arguments filed 7/28/2006 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Herring ‘841 requires the use of inorganic particulates which is excluded by present claim language “consisting of”; (B) that nothing in

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Herring '841 suggests the desirability of using the presently claimed organic fillers; and (C) that Trask et al does not suggest using its composition in an insulation material.

With respect to argument (A), in col. 3, lines 62-63 of Herring '841, it states that “[i]norganic reinforcing particulates *can* be included in the elastomeric insulating materials of the invention” (emphasis added). The term “can” suggests that the inorganic reinforcing particulates are optional. Case law holds that it is perfectly proper for the examiner to look to the whole reference for what it teaches rather than merely rely on preferred embodiments. *In re Courtright* 153 USPQ 735 (CCPA 1967).

With respect to argument (B), Herring '841 discloses the use of polymeric filler, and it is the examiner's position that it would have been obvious to one of ordinary skill in the art to use the polymeric fillers disclosed by Herring 841 or other suitable polymeric fillers especially since Trask et al provides motivation and, specifically advantages had by using the presently claimed fillers.

With respect to argument (C), Trask et al is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/3/2006

Vickey Ronesi



Vasu Jagannathan
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